

REMARKS

Claims 58-75 are currently pending in this application. For each of the following reasons, Applicants believe that each of these claims is allowable.

The Office has requested that Applicants submit a new oath or declaration that clarifies the basis for reissue and which states that any ~~error~~ was made without deceptive intent on part of the applicant. Attached as Exhibit A is a newly executed oath that includes such requested information. As such, Applicants believe that they have overcome this rejection.

The Office also requested that claims 59-73, which were added by the Preliminary Amendment dated July 18, 2003, should have been underlined to illustrate that such claims added new matter. While such claims were designated as "New" in the Preliminary Amendment, Applicants have underlined the claims in the current Listing of Claims to further illustrate that such claims are new to this application, as originally filed. Any new claim language added in this Amendment is italicized as well as underlined.

The Office also objected to claims 59, 63 and 65-66. Applicants have deleted the term "elongated" from claims 63 and 66 to remove any alleged inconsistencies in the language of these claims. Applicants believe that they have overcome these claim rejections as well.

Finally, the Office has rejected all pending claims under 35 USC § 103 as being obvious in light of varying combinations of McCabe (USP 3,671,685), Miyahra (USP 4,447,677), Killion (USP 4,677,679) and Kelsey (USP 2,430,229).¹ Applicants

¹ Claims 59, 67, 68 and 73 were presumably rejected in light of Kelsey (the Action initially cites the remaining three patents but then, in describing specifically the basis for the rejection, only cites to the Kelsey patent). Claims 59-68 and 73 were rejected in light of Miyahra. Claims 69-72 were rejected in light of a combination of Kelsey, Miyahra and Killion.

respectfully submit that the cited references, either alone or in combination, do not teach or suggest Applicants' claimed invention.

Specifically, for example, the combination of references cited in the Office Action does not teach, among other things, "the earphone providing a high fidelity response without requiring a long flexible tube between the hollow tubular portion of the housing and the resilient sealing member," as claimed by Applicants. Applicants submit, therefore, that Applicants' claims are non-obvious in view of the cited references.

One important indicator of the non-obviousness of an invention is the failure of others to achieve the invention. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 U.S.P.Q. 459 (1966). The Applicants are believed to be the first to have successfully designed and built a high-fidelity insert earphone. The Applicants' unique combination of elements compensates for loss of external ear resonance and results in an earphone that achieves high fidelity reproduction. To Applicants' knowledge, none of the prior art references, either alone or in combination, achieve high fidelity reproduction as does Applicants' invention.

Another important indicator of the non-obviousness of an invention is praise of the invention by experts. See, e.g., *Litton Systems Inc. v. Honeywell, Inc.*, 39 U.S.P.Q.2d 1321, 1327 (1996). Applicants' invention has been met with high praise from experts in the audio industry. In fact, many experts believe that Applicants' earphones are perhaps the best available on the market and succeed where many others have failed.

For example, an article from the December 1994 issue of *Stereo Review* states:

"While other headphone companies use an ear-canal/difference field match as their design ideal, no other phones comes close to realizing it as the Etymotic ER-4S, which is specifically designed to operate in the predictable and controlled sonic environment created by earplugs. The result is sound that's more neutral and uncolored than from any

headphones or earphones I've ever used, though a few very expensive – and hardly portable – electrostatic models have come close.

* * *

With the extreme noise isolation provided by its earplug-based design and its reference-standard sound quality, the ER-4S is the closest thing yet to direct sonic connection to the brain."

Other expert reviews of Applicants' invention include the following:

"These are the finest earphones or headphones I've ever heard ... These tiny units deliver reference-quality sound that is astonishing...Quite simply, these are the most transparent, revealing 'phones I've had the pleasure to hear."

- *High Performance Review*, Summer 1994

"If you are looking for earphones that reduce outside noise, you will find none better than ER-4s....the bass is phenomenal; you will hear low-frequency sounds that you didn't even think were possible...overall sound quality rate of "excellent.""

- *Audio*, December 1993

"Wow!" ...If you're not planning on staying home...and want to take high-quality listening into places where it just hasn't been possible before – well, I'm not even sure you have another choice [than the ER-4S]. It really *is* that simple."

- *Stereophile*, Vol. 18, No. 7, July 1995

"They [the ER-4S] offer more isolation from outside sounds than any other phones that I know of..the Etymotic ER-4S earphones are among the least colored, most detailed earphones or headphones I have ever heard.... These are the most transparent phones I have had the pleasure to audition."

- *Pro Audio Review*, October 1997

Clearly such evidence further demonstrates the non-obviousness of Applicants' invention and supports allowability of the pending claims.

In view of the foregoing, it is respectfully submitted that the pending claims define allowable subject matter. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Dated: July 25, 2005

Respectfully submitted,



Ronald H. Spuhler
Reg. No. 52,245

McAndrews, Held & Malloy, Ltd.
500 West Madison Street
34th Floor
Chicago, IL 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100